This application has been carefully reviewed in light of the Office Action dated April 28, 2011. Claims 1, 4, 5, 7, 9, 13, 15, 16, 21, 27 and 33 to 68 are pending in the application of which Claims 1, 7 and 13 are independent. Claims 66 to 68 are newly added claims. Reconsideration and further examination are respectfully requested.

OBJECTIONS

Claims 1, 7 and 13 were objected to for informalities. The Office Action suggested changing "user" at line 14 of Claim 1 to "a user" and making similar changes to Claims 7 and 13. Applicant has adopted those suggestions in amending Claims 1, 7 and 13. Claims 33-35 were objected to for informalities based on the phrase "plain paper based the entire print attribute". Claims 33 to 35 have been amended to recite "plain paper based on the entire print attribute". It is believed that the objections have been obviated and respectfully request that the objections be withdrawn.

REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Claims 63 to 65 were rejected under 35 U.S.C. §112, second paragraph as allegedly being indefinite. Reconsideration and further examination are respectfully requested. Without conceding the propriety of the rejections, Claims 63 to 65 have been amended to more fully comply with the requirements of 35 U.S.C. §112, second paragraph. Accordingly, Applicants respectfully request withdrawal of the rejections of Claims 63 to 65 under 35 U.S.C. §112, second paragraph.

OFFICIAL NOTICE

Before turning to the art based rejections, Applicant wishes to address

certain portions of the Office Action which invoke Official Notice. For example, at page

8, lines 11 and 12, and lines 19 and 20 the Office Action states:

> "Official Notice is taken that it is well known and obvious to
> a person of ordinary skill in the art to output print data as a
> bitmap (See MPEP 2144.03)."

> "Official Notice is taken that it is well known and obvious to
> a person of ordinary skill in the art to provide a print user
> interface via a printer driver (See MPEP 2144.03)."

Also, at page 9, lines 6 and 7, the Office Action states:

> Official Notice is taken that it is well known and obvious to
> a person of ordinary skill in the art to designate a sheet
> feeding method."

MPEP 2144.03 states, in part,

> "Official notice unsupported by documentary evidence
> should only be taken by the examiner where the facts
> asserted to be well-known, or to be common knowledge in
> the art are capable of instant and unquestionable
> demonstration as being well-known. As noted by the court in
> *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420
> (CCPA 1970), the notice of facts beyond the record which
> may be taken by the examiner must be "capable of such
> instant and unquestionable demonstration as to defy dispute"
> (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ
> 6 (CCPA 1961))."

> "It would not be appropriate for the examiner to take official
> notice of facts without citing a prior art reference where the
> facts asserted to be well known are not capable of instant and
> unquestionable demonstration as being well-known. For
> example, assertions of technical facts in the areas of esoteric
> technology or specific knowledge of the prior art must
> always be supported by citation to some reference work
> recognized as standard in the pertinent art."

> "It is never appropriate to rely solely on 'common
> knowledge' in the art without evidentiary support in the

- 16 -

> record, as the principal evidence upon which a rejection was
> based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697."

Applicant respectfully traverses the taking of Official Notice on the grounds that the statements of facts repeated above from the Office Action are believed to be assertions of technical facts in the areas of esoteric technology and are not capable of instant and unquestionable demonstration as being well-known. Accordingly, Applicant respectfully requests that the Office provide documentary evidence showing the officially noticed facts which are conceded by the Office as not being disclosed by the applied art.

ART BASED REJECTIONS

Claims 1, 4, 7, 9, 13, 16, 33 to 35, 45, 47 to 50, 52 to 55 and 57 to 65 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,159,190 (Perry). Claims 5, 17, 46, 51 and 56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Perry in view of what the Office Action alleges is Applicant's admitted prior art (AAPA). Claims 15, 21 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Perry in view of U.S. Patent No. 6,724,492 (Iwase). Claims 36 to 44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Perry and further in view of U.S. Patent No. 6,621,590 (Livingston). Reconsideration and withdrawal of these rejections is respectfully requested.

Turning now to the rejections, the present claims concern setting printer settings by a printer control apparatus using a setting screen to set a print attribute to be applied to the print data and a partial setting screen to set a partial print attribute to be applied to a part of the print data. In one aspect, the printer control apparatus displays a setting screen to set a print attribute to be applied to the print data and then displays a partial setting screen including (i) a first designation field to set a partial print attribute to

be applied to a part of the print data, and (ii) a second designation field to designate a page as the part of the print data to which the partial print attribute is applied. Since an initial value of the first designation field in the partial setting screen indicates that a print attribute that is the same as the entire print attribute is already set, it is not required that a user reenter a partial attribute which has the same value as the print setting attribute.

Turning to specific claim language, independent Claim 1 is directed to a printing control method executed in an information processing apparatus which has a printer driver to generate print data which a printing apparatus can process. The printing control method includes a first displaying step of displaying an entire setting screen to set an entire print attribute to be applied to entire print data. The method also includes a changing step of changing a first print attribute which is an initial value of the entire setting screen displayed in the first displaying step for a second print attribute. Also, the method includes a second displaying step of displaying a partial setting screen including (i) a first designation field to set a partial print attribute to be applied to a part of the entire print data, (ii) a second designation field to designate a page as the part of the entire print data to which the partial print attribute is applied. The second print attribute for the entire print data changed in the changing step is displayed on the partial setting screen before a user sets the partial print attribute. Further, the method includes a generating step of generating the print data based on the entire print attribute and the partial print attribute. The entire setting screen and the partial setting screen are provided by the printer driver.

Applicant submits that Perry fails to disclose the features of the present claims. In particular, Perry fails to disclose or suggest displaying a partial setting screen including (i) a first designation field to set a partial print attribute to be applied to a part of

the entire print data, (ii) a second designation field to designate a page as the part of the entire print data to which the partial print attribute is applied, wherein the second print attribute changed for the entire print data is displayed on the partial setting screen before user sets the partial print attribute.

In contrast, Perry discloses systems and methods for navigating and displaying print job exception information. A user can apparently set print job level properties and print job exception attributes through user interfaces shown in Figs 5 and 6A-6D. When the user selects the print job exception attributes, only print job exception attributes, which are different from the print job level properties, are displayed according to explanations, for example Fig. 4 and column 5, lines 46-51, in Perry. Therefore, Figs 6A to 6D of Perry fail to disclose or suggest changing a first attribute of the entire print data to a second attribute to second attribute, and then displaying a partial setting screen including (i) a first designation field to set a partial print attribute to be applied to a part of the entire print data, (ii) a second designation field to designate a page as the part of the entire print data to which the partial print attribute is applied, wherein the second print attribute changed for the entire print data is displayed on the partial setting screen before a user sets the partial print attribute.

At page 4, the Office Action concedes that Perry "does not disclose expressly wherein the partial setting screen displays the second print attribute for the entire print data that has been changed from an initial value." Nonetheless, to remedy this deficiency of Perry, the Office Action states:

> "At the time of the invention, it would have obvious to a
> person of ordinary skill in the art to display the current print
> attributes for the entire print data in the partial setting screen.
> The motivation for doing so would have been to avoid

> requiring that a user must manually reenter every print attribute even when a change for only one attribute is desired. The system of Perry'190 includes at least multiple attributes …"

> "Considering the number of print job attributes, it would be unreasonable to require a user to manually input each print job attribute whenever they make a print job exception."

The above-repeated portions of the Office Action appear to rely on Official Notice to support the conclusion of obviousness. The Office Action asserts specific knowledge of the prior art reference, i.e., Perry. However, the Office Action does not cite to a prior art reference where the facts asserted to be well known are capable of instant and unquestionable demonstration as being well-known. Moreover, Applicant submits that the assertions made in the Office Action relate to technical facts in an area of esoteric technology. Since Office policy makes clear that it would <u>not</u> be appropriate for the Examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known, Applicant deems the conclusions of obviousness as being unsupported by the applied art.

Moreover, Applicant submits that the above-repeated portions of the Office Action also appear to be conclusion of obviousness based on an improper hindsight reconstruction of Perry based on Applicant's disclosure. See MPEP § 2145.

Accordingly, for at least these two reasons, Applicant submits that a *prima facie* case of obviousness has not be established. However, if the rejection of Claim 1 is maintained over Perry, Applicant respectfully requests that the Examiner support the above-repeated assertions by citation to some reference work recognized as standard in the pertinent art. See, MPEP § 2144.03.

In contrast to the characterizations of Perry presented in the Office Action, Perry is understood by Applicant to teach that only print job exception attributes that are different from print job level properties are displayed, as discussed at block 5020 of Fig. 4 and as shown in Figs. 5 and 6A to 6D of Perry. Accordingly, any default values defined in advance can be employed only as initial values of the print job exception attributes, and not the entire print attributes.

In contrast, by virtue of the features of Claim 1, values of the entire print attributes are reflected to the partial print attributes even if the entire print attributes have been changed for executing the print job. The second displaying step is performed to reflect the changed attribute in the entire print attributes to the partial print attributes. This is a feature distinguishable from Perry even if the line of reasoning proposed by the Office Action, and repeated above, is accepted, which again it is not accepted.

In light of the deficiencies in Perry, Applicant submits that Claim 1 is in condition for allowance and respectfully requests same.

Claims 7, 11 and 13 are directed to an apparatus, a system and a computer-readable storage medium, respectively, substantially in accordance with the method of Claim 1. Accordingly, Applicant submits that Claims 7, 11 and 13 are also in condition for allowance and respectfully request same.

The other pending claims in this application are each dependent from the independent claims discussed above and are therefore believed allowable for at least the same reasons. Because each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, the entire application is believed to be in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

CONCLUSION

Any fees believed to be due are being paid concurrently herewith. The Director is hereby authorized to credit any fee overpayment, or charge any fee underpayment, to Deposit Account No. 06-1205.

Applicant's undersigned attorney may be reached in our Costa Mesa, CA office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

/ Christian Mannino 58,373/
Christian Mannino
Registration No. 58,373
Attorney for Applicant

FITZPATRICK, CELLA, HARPER & SCINTO
1290 Avenue of the Americas
New York, York 10104-3800
Facsimile: (212) 218-2200

FCHS_WS 6710344v1.doc